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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,752	04/17/2001	James D. Bennett	P93-00-AC	8896

7590 12/18/2002

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EXAMINER
KNEPPER, DAVID D

ART UNIT	PAPER NUMBER
2654	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,752	BENNET ET AL	
	Examiner	Art Unit	
	David D. Knepper	2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 April 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Applicant's correspondence filed on 17 April 2001 (IDS, paper #5 and Amendment, paper #6) has been received and considered. Claim 11 is pending. Claims 1-10 have been canceled.

2. The IDS of paper #5 has not been considered because it provides PTO Form 892 listings, which are for the Examiner's listing of cited references. The applicant must follow 37 CFR 1.98 and 1.97 to provide a list (recommend use of PTO Form 1449), copies of references, statement of relevancy (required for non-English references) and any fees and/or certification statements depending on the time of submission.

3. The incorporation of patents 5,926,787 and 5,815,639 is improper because they also incorporate by reference (see MPEP 608.01(p)). The applicant must extract the essential material from the references and place it in the instant application.

Abstract

4. The Abstract of the Disclosure is objected to because it is identical to the abstracts of 5,926,787 and 5,815,639. The abstract should be changed to reflect the key difference(s) that would support a separate patent. Correction is required. See M.P.E.P. § 608.01(b).

Claims

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 11 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3 and 6-9 of prior U.S. Patent No. 5,926,787 and also claims1, 4, 12 and 15 of patent 5,815,639. This is a double patenting rejection.

"receiving...representations of words" ('787 = representations for words spoken; '639 = representations of spoken words);

"converting, in real-time, said representations to text" ('787 = identify exact textual representations for words spoken in real time; '639 = words in a first phoneme format generated in real time and text for coded representations);

"translating...the text in the first language to text in a second language ('787 = foreign language translation; '639 = foreign language translation); and

"communicating the text in the second language to a terminal for real-time display" ('787 = directing display of the exact textual representations and the substitute text on the screen; '639 = delivering both the exact alphabetic and numeric text . . . to the viewing terminal for display).

Although the text chosen to describe the invention is somewhat different in the patents as compared to the instant application, it is clear that the inventions are the same.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 11 is are rejected under 35 U.S.C. § 103 as being unpatentable over Lefler (4,724,285) in view of Yoshida (4,412,305).

Claim 11 is taught or suggested by Lefler's figure 2:

"receiving...representations of words" (his stroke symbol generator 152 and/or steno keyboard 112 and/or item 200);

"converting, in real-time, said representations to text" (his translator processor 158 – see also col. 6, lines 67-68 where the processor 158, enables the processor to receive a dictionary word);

"translating...the text in the first language to text in a second language (suggested by his indication that his translator 130 can then provide output data to or accept input data from any suitable device . . . allowing the processor 158 to communicate with a different auxiliary device – see also Yoshida who can receive words, such as sentences, idioms and phrases [that] can be translated from a first language into a second language, abstract, and figure 1); and

"communicating the text in the second language to a terminal for real-time display" (Yoshida's display 17).

It is noted that Lefler does not explicitly teach "translating...the text in the first language to text in a second language". However, he teaches that it is desirable to send the translated text to other auxiliary devices to include word processors and other computers to allow greater functionality. Yoshida teaches a computer that is able to translate text from one language to another. It would have been obvious for a person having ordinary skill in the pertinent art, at the time the invention was made, to combine the computer translation device of Yoshida with the stenographic translation system of Lefler because Lefler teaches that his device is designed to allow connection with other computer devices for further processing of text.

Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stentiford (5,384,701) is cited to show that language translation is well known.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

TC2600 Fax Center
(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David D. Knepper whose telephone number is (703) 305-9644. The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached on (703) 305-4379.

Any inquiry of a general nature or relating to the status of this application should be directed to customer service whose telephone number is (703) 306-0377.

David D. Knepper
Primary Examiner
Art Unit 2654
December 14, 2002